

REMARKS

Applicants note with appreciation the allowance of claims 30-32. Applicants also note with appreciation the indication that claims 12, 13, 15, 16 and 17 would be allowable if rewritten in independent form to include all of the limitations of the claims on which they depend. However, claims 12, 13, 15, 16 and 17 are not rewritten herein because these claims are believed to be allowable as being dependent on an allowable base claim as explained below.

Claims 1-29 are rejected as being indefinite under the second paragraph of 35 U.S.C. § 112. The recitation in claim 1 of "a thermoplastic resin other than a polyester resin" is stated to be indefinite.

The 35 U.S.C. § 112 rejection is avoided by the above amendment to claim 1 to limit the "thermoplastic resin other than a polyester resin" to a polyimide resin, a polysulfone resin or a poly(ether sulfone) resin (or a mixture thereof) as originally recited in claim 6. Claim 6 has been cancelled.

Claims 1-29 are also rejected as being obvious under 35 U.S.C. § 103(a) over the disclosure of EP 0 985 701 A1 ("EP '701"). Reconsideration and removal of this rejection are respectfully requested. EP '701 fails to provide the necessary motive to a person of ordinary skill in the art to modify the polyester film as

disclosed therein in the manner required to obtain the polyester film recited in claim 1 of the present application.

The polyester film of the present invention (as recited in claim 1) is a film formed of a polyester resin and a thermoplastic resin other than a polyester resin, in which the number H1 of coarse projections having a height of 0.28 μm or more per 100 cm^2 of at least one surface of the polyester film and the number H2 of coarse projections having a height of 0.56 μm or more per 100 cm^2 of said at least one surface of the polyester film satisfy the equations, $0 \leq H1 \leq 100$ and $0 \leq H2 \leq 10$.

The polyester film of the present invention in which both of these relationships are satisfied has superior properties; particularly superior properties as a film for a metal evaporated magnetic recording medium. If only one of these relationships is satisfied, as shown by the data of Comparative Examples 7 and 15 in which H1 is greater than 100 and outside the range recited in claim 1 (while H2 is within the recited range), the film will not have the superior properties.

EP '701, on the other hand, discloses only that it is preferable that the polyester film therein have less than 30/100 cm^2 of coarse protrusions with a protrusion height of 0.5 μm or more. EP '701 does not disclose or suggest the improved properties

of a polyester film in which the number of coarse projections of 0.28 μm or more per 100 cm^2 of at least one surface of the polyester film and the number of coarse projections having a height of 0.56 μm or more per 100 cm^2 of the at least one surface of the polyester film satisfy specified ranges.

Obviousness must come within the teachings of the prior art. The prior art, however, fails to provide a teaching, suggestion or motive to the art-skilled person to modify the film of EP '701 as required to obtain the polyester film of the present invention. Removal of the 35 U.S.C. § 103(a) rejection of claims 1-29 is in order.

The foregoing is believed to be a complete and proper response to the Office Action dated August 7, 2003, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

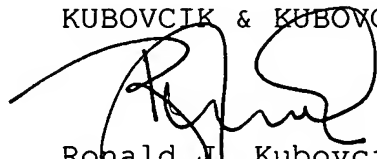
In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

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In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

KUBOVCIK & KUBOVCIK

A handwritten signature in black ink, appearing to read 'Ronald J. Kubovcik', is written over the printed name and registration number.

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